

REMARKS

Claims 1-16 and 31-34 are currently pending in this application. Claims 17-30 have been withdrawn from consideration.

§ 103 Rejection of the Claims

Claims 1-10, 12-16 and 31-34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekiya (JP 04-151208). Applicants respectfully assert that the claims as amended are unobvious. Withdrawal of this rejection is respectfully requested.

To establish a *prima facie* case of obviousness, three basic criteria must be met: 1) a suggestion or motivation to modify the reference(s) or to combine teachings; 2) a reasonable expectation of success; and 3) the references, when combined, must teach or suggest all the claim limitations. *See In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP § 2143 *et seq.* A conclusion of obviousness can therefore only be made after a finding that there is a reason, suggestion, or motivation to lead one skilled in the art to combine references. *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). The possible sources for motivation to combine references are: (a) the nature of problem being solved; (b) the teaching of the prior art; and (c) the knowledge of one skilled in the art. *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); and MPEP § 2143.01.

When making an obviousness determination, a claimed invention must be considered as a whole. One must avoid hindsight and step back in time just before the invention was made into the mind of a hypothetical "Person of Ordinary Skill in the Art" who does not know the invention. *In re Dembiczak*, 175 F.3d, 994, 999; 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999).

The phrase, "at the time the invention was made" is important to consider so as to guard against applying hindsight. *Id.* To avoid the "powerful attraction" of hindsight requires a rigorous application of showing the teaching or motivation to combine prior art references. *Id.*

In *Dembiczak*, the appellants' claims in their patent application were directed toward a large trash bag made of orange plastic that when filled with trash or leaves would resemble a Halloween-style pumpkin or jack-o'-lantern. The claims specified "facial indicia" on the outer surface of the bag. *Id.* at 995; 1615. Among the references cited by the examiner in an obviousness rejection under 35 U.S.C. 103 were "conventional" plastic lawn bags and a children's book describing a method of making a "paper bag pumpkin" by stuffing a bag with newspapers, painting it orange, and then painting on facial features with black paint.

The Federal Circuit emphasized that obviousness rejections require a clear and particular showing of the teaching or motivation to combine prior art references, which most often comes from the teachings of the pertinent references, and must be supported by actual evidence. *Id.* at 999; 1618. The Federal Circuit also stated that close adherence to the methodology for analyzing 103 rejections is "especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'" *Id.* at 999; 1617, quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540; 220 U.S.P.Q. 303 (Fed. Cir. 1983).

The present invention is directed, in part, to an etched metal article, the metal article comprising a compression-formed particulate metal object; wherein a portion of the compression-formed particulate metal object has been selectively removed by an abrasive

etching process from at least one surface of the object. Sekiya fails to teach or make obvious the claimed invention because it fails to make obvious all elements of the invention. In particular, applicants note that Sekiya fails to teach either a compression-formed particulate metal object or abrasive etching of a compression-formed particulate object. In regard to the first of these limitations, the claimed invention requires that use of a compression-formed object, typically under high pressures. The metal particles of the present invention are formed into rigid or substantial rigid objects by compression, resulting in a dense material that has a weight and conductivity approaching that of solid metal, and also reduces the voids between the particles, thereby increasing the similarity in appearance to a solid metal. *See, e.g.*, page 9, lines 4 to 16. As explained at page 2, lines 21 to 22, one of the important advantages of the present invention is that metals are strong enough to be handled, moved and processed, even without sintering.

In contrast, Sekiya does not teach compression of the metal under pressure. One reason for this may be that Sekiya is not concerned with whether or not the metal will have an appearance like solid metal, or whether it will have a weight similar to solid metal, perhaps because Sekiya appears to be directed to use as a leather stamp, rather than as a metal article for which desirable aesthetic properties are sometimes necessary.. In contrast, one of the present advantages of the claimed invention is the aesthetic benefit of a compressed metal.

In addition to the fact that Sekiya fails to teach or suggest compression formed materials, Sekiya teaches in the abstract the use of an acid material to etch the surface of the metal. This runs in conflict to the claimed invention, which teaches away from acid etching processes, noting that they are time consuming, use hazardous materials, and are non-directional, resulting in

frequent undercutting of the mask during etching. *See, e.g.*, page 1, lines 14 to 18. Instead, the present invention is directed, as claimed, to abrasively etched materials.

For the foregoing reasons, Applicants believe that Sekiya fails to teach or suggest the claimed invention, and thus the claimed invention is non-obvious in view of Sekiya.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiya (JP 04-151208) in view of GB '219 (GB 66,219). For the reasons identified above, applicants believe Sekiya does not teach or suggest the claimed invention, even in combination with GB '219.

In view of the foregoing arguments, applicants respectfully request reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 612.746.4783 or by E-mail at dpauly@pdsdlaw.com with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 50-3688.

Respectfully Submitted,

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